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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,707	11/06/2000	Masaki Kyojima	107750	7854
25944	7590	11/01/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			WORJLOH, JALATEE	
		ART UNIT		PAPER NUMBER
		3621		

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/705,707	KYOJIMA ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Jalatee Worjloh	3621		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 9-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 5-7 is/are allowed.
- 6) Claim(s) 9-18 and 20-33 is/are rejected.
- 7) Claim(s) 19 and 34-36 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/05/2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 20-23,30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6223166 to Kay.

Kay discloses electronically preparing verification information (i.e. “asymmetric key”) required for verifying a legitimacy of a booking certificate, the booking certificate certifying that a supply of a product and/or service is booked in advance for a specific consumer, electronically preparing an encrypted public key pair, electronically holding a private key out of the public key pair (*notice, the asymmetric keys are stored in memory*), wherein the verification information is a public key out of the public key pair and the booking certificate is prepared by using the private

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key (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26), electronically inputting information for identifying the verification information, electronically preparing a booking certificate verifiable with the verification information identified by the inputted information for identifying verification information (see col. 3, lines 66,67; col. 4, lines 1-9 and col.5, lines 30-33) and electronically outputting the booking certificate thus prepared (see col. 4, lines 29-31).

Referring to claim 2, Kay discloses verification information preparing means (i.e. website) for preparing verification information (i.e. “asymmetric key”) required for verifying a legitimacy of a booking certificate, the booking certificate certifying that a supply of a product and/or service is booked in advance for a specific consumer, encrypted public key pair preparing means for preparing an encrypted public key, private key holding means (i.e. terminal memory) for holding private key out of the public key pair prepared by the encrypted public key pair preparing means, wherein the verification information is a public key prepared by the encrypted public key means, and the booking certificate is prepared by using the private key held by the private key holding means (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26; col. 6, lines 17-20), verification information output means (i.e. “portable scanner”) for outputting the verification information prepared by the verification information preparing means (see col. 4, lines 37-41) booking certificate output means (i.e. user’s printer) for outputting the booking certificate thus prepared (see col. 4, lines 29-31).

Referring to claim 20, Kay discloses electronically storing verification information (i.e. “asymmetric key”) for verifying a booking certificate certifying that a supply of a product and/or a service is booked in advance for a specific consumer, *notice, the asymmetric keys are stored in terminal memory* (see col. 5, lines 56-60), electronically inputting the booking certificate (see

col. 4, lines 37-41), electronically verifying the legitimacy of the input booking certificate by using the stored verification information (see col. 4, lines 51-61), electronically preparing an encrypted public key pair, electronically holding a private key out of the public key pair, wherein the verification information is a public key out of the public key pair and the booking certificate is prepared by using the private key (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26).

Referring to claim 21, Kay discloses verification information storage means (i.e. “terminal computer”) for storing verification information (i.e. “asymmetric key”) for verifying a booking certificate certifying that a supply of a product and/or a service is booked in advance for a specific consumer, *notice, the asymmetric keys are stored in terminal memory* (see col. 5, lines 56-60), booking certificate verification means, to which the booking certificate is inputted, for verifying the legitimacy of the input booking certificate by using the stored verification information (see col. 4, lines 51-61), encrypted public key pair preparing means for preparing an encrypted public key pair, private key holding means for holding a private key out of the public key pair, wherein the verification information is a public key out of the public key pair and the booking certificate is prepared by using the private key (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26).

Referring to claim 22, Kay discloses connection means (i.e. “communication unit”) for connecting a portable memory apparatus holding the booking certificate, wherein the booking certificate verification means (i.e. “central information system”) verifies through the connection means the legitimacy of the booking certificate stored in the portable memory apparatus (see col. 4, lines 58-66).

Referring to claim 23, Kay discloses the booking certificate is usable to be downloaded to a portable memory unit to be presented for receiving the booked product and/or service (see col. 4, liens 36-41).

Referring to claim 30, Kay discloses instructions (i.e. HTML code), see col. 5, lines 35-38, for: preparing verification information (i.e. “asymmetric key”) required for verifying a legitimacy of a booking certificate, the booking certificate certifying that a supply of a product and/or service is booked in advance for a specific consumer, preparing an encrypted public key pair, holding a private key out of the public key pair (*notice, the asymmetric keys are stored in memory*), wherein the verification information is a public key out of the public key pair and the booking certificate is prepared by using the private key (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26), inputting information for identifying the verification information, preparing a booking certificate verifiable with the verification information identified by the inputted information for identifying verification information (see col. 3, lines 66,67; col. 4, lines 1-9 and col.5, lines 30-33) and outputting the booking certificate thus prepared (see col. 4, lines 29-31).

Referring to claim 33, Kay discloses instructions (see col. 5, lines 35-38) for: storing verification information (i.e. “asymmetric key”) for verifying a booking certificate certifying that a supply of a product and/or a service is booked in advance for a specific consumer, *notice, the asymmetric keys are stored in terminal memory* (see col. 5, lines 56-60), inputting the booking certificate (see col. 4, lines 37-41), verifying the legitimacy of the input booking certificate by using the stored verification information (see col. 4, lines 51-61), preparing an encrypted public key pair, holding a private key out of the public key pair, wherein the verification information is

a public key out of the public key pair and the booking certificate is prepared by using the private key (see abstract, lines 1-6; col. 5, lines 56-60; col. 4, lines 14-26).

4. Claims 9-18, 25, 27, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6189146 to Misra et al.

Misra et al. disclose electronically receiving a first request for booking certificate (i.e. “license”), which is a request for an issuance of a booking certificate certifying an advance booking of a specific product and/or service (see col. 11, lines 36, 37 and 46-51), electronically outputting a second request for booking certificate thus prepared (see col. 11, lines 60, 66, and 67). Notice. Misra et al. teach an intermediate server that “acts as a go between for the client and license sever”; the client connects to the intermediate server and requests a license (i.e. “first request”). Next, the intermediate server validates the client’s request, which includes a client ID and transmits the request to the license server (i.e. “second request”). As for the step of preparing the second request, this is an inherent step; that is, before outputting the request it must have previously created.

Referring to claim 10, Misra et al. disclose booking certificate request acceptance means (i.e. “intermediate server”) for accepting a first request for booking certificate, which is a request for an issuance of a booking certificate certifying an advance booking of a specific product and/or service (see col. 11, lines 36, 37 and 46-51), booking certificate request output means (i.e. “intermediate server”) for outputting a second request for booking certificate thus prepared (see col. 11, lines 60, 66, and 67). Notice. Misra et al. teach an intermediate server that “acts as a go between for the client and license sever”; the client connects to the intermediate server and

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requests a license (i.e. "first request"). Next, the intermediate server validates the client's request, which includes a client ID and transmits the request to the license server (i.e. "second request"). As for a booking certificate request preparing means for preparing a second request, this is an inherent; that is, before outputting the request it must have previously created.

Referring to claim 11, Misra et al. disclose verification information (i.e. "client ID") needed for verifying a legitimacy of a specific booking certificate is associated with a specific product and/or service, and the first and second requests for booking certificates contain information for identifying verification information for specifying the product and/or service for which a booking certificate is requested with the requests (see col.11, lines 51-53).

Referring to claim 12, Misra et al. disclose booking conditions preparing means for preparing booking conditions to contained in the requested booking certificate, wherein the second request for booking certificate prepared by the booking certificate request preparing means contains the booking conditions prepared by the booking conditions preparing means (see col. 11 table; col. 15, lines 30-36).

Referring to claim 13, Misra et al. disclose booking certificate intermediation license storage means for holding a booking certificate intermediation license to certify that the system is licensed for intermediation of the first request for booking certificate regarding the specific product and/or service, wherein: the second request for booking certificate, outputted from the booking certificate request output means contains the booking certificate intermediation license to intermediate the first request for the booking certificate regarding the specific product and/or service (see col. 2, lines 16-21; col. 5, lines 3-12, 26-32; col. 6, lines 31-45).

Referring to claims 14 and 15, Misra et al. disclose billing means (i.e. "license generator at the clearinghouse") for chagrining a fee for booking certificate issuance to a requester of the first request for booking certificate, wherein the fee is charged by the billing means to the requester when the first request for booking certificate is inputted; account settlement means (i.e. "clearinghouse") for collecting a fee for booking certificate issuance from a requester of the first request for booking certificate, wherein the fee is collected by the account settlement means from the requester when the first request for booking certificate is inputted (see abstract, liens 1-6).

Referring to claim 16, Misra et al. disclose electronically inputting information for identifying an intermediary to perform intermediation of a request for a booking certificate certifying that a supply of a product and/or service is booked in advance by a specific consumer,

electronically inputting information for specifying the product and/or service for which the intermediary is licensed for intermediation, electronically preparing a booking certificate intermediation license for certifying that the intermediation of the request for booking certificate for the product and/or service specified by the later input information is licensed to the intermediary identified by the former input information, electronically outputting the booking certificate intermediation license certificate thus prepared (see col. 6, lines 31-45, 50-60), wherein the booking certificate is prepared by using a private key of a public key pair (see col. 7, lines 15-18).

Referring to claim 17, Misra et al. disclose booking certificate intermediation license preparing means, to which information for identifying an intermediary to perform intermediation of a request for a booking certificate certifying that a supply of a product and/or service is booked in advance by a specific consumer and information for specifying a product and/or service for which the intermediary is licensed for intermediation is inputted for preparing a booking certificate intermediation license for certifying that the intermediary identified by the former input information, and certificate intermediation license output means for outputting the booking certificate intermediation license prepared by the booking certificate intermediation license preparing means (see col. 6, lines 31-45, 50-60), wherein the booking certificate is prepared by using a private key of a public key pair (see col. 7, lines 15-18).

Referring to claim 18, Misra et al. disclose booking conditions limitation information preparing means for preparing booking conditions limitation information, which is information for limiting a scope of booking conditions, which are conditions for limiting booking particulars to be entered in the booking certificate issued by intermediation by the intermediary, who is the

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recipient of the license, wherein the booking certificate intermediation license prepared by the booking certificate intermediation license preparing means contains the booking conditions limitation information prepared by the booking conditions limitation information preparing means.

Referring to claims 25 and 27, Misra et al. disclose the booking certificate is usable to be downloaded to a portable memory unit to be presented for receiving the booked product and/or service (see col. 2, lines 43-46).

Referring to claim 31, Misra et al. disclose instructions (see col. 5, lines 26-28, 50-54) for: receiving a first request for booking certificate (i.e. "license"), which is a request for an issuance of a booking certificate certifying an advance booking of a specific product and/or service (see col. 11, lines 36,37 and 46-51), outputting a second request for booking certificate thus prepared (see col. 11, lines 60, 66, and 67). Notice. Misra et al. teach an intermediate server that "acts as a go between for the client and license sever"; the client connects to the intermediate server and requests a license (i.e. "first request"). Next, the intermediate server validates the client's request, which includes a client ID and transmits the request to the license server (i.e. "second request"). As for the step of preparing the second request, this is an inherent step; that is, before outputting the request it must have previously created.

Referring to claim 32, Misra et al. disclose instructions (see col. 5, lines 26-28, 50-54) for inputting information for identifying an intermediary to perform intermediation of a request for a booking certificate certifying that a supply of a product and/or service is booked in advance by a specific consumer, inputting information for specifying the product and/or service for which the intermediary is licensed for intermediation, preparing a booking certificate intermediation license

for certifying that the intermediation of the request for booking certificate for the product and/or service specified by the later input information is licensed to the intermediary identified by the former input information, outputting the booking certificate intermediation license certificate thus prepared (see col. 6, lines 31-45, 50-60), wherein the booking certificate is prepared by using a private key of a public key pair (see col. 7, lines 15-18).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Kay as applied to claim 2 above, and further in view of US Patent No. 6189146 to Misra et al.

Kay discloses a booking certificate preparing means for preparing booking certificates (see claim 2 above). Kay does not expressly disclose booking conditions preparing means for preparing booking conditions, which are conditions for limiting booking particulars, wherein the booking certificate prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means. Misra et al. disclose booking conditions preparing means for preparing booking conditions, which are conditions for limiting booking particulars, wherein the booking certificate prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means (see col. 11 table; col. 15, lines 30-36). At the time the invention was made, it would

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have been obvious to a person of ordinary skill in the art to modify the method disclose by Kay to include booking conditions preparing means for preparing booking conditions, which are conditions for limiting booking particulars, wherein the booking certificate prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means. One of ordinary skill in the art would have been motivated to do this because it prevents an issued certificate from being illegally used (see col. 3, liens 16-21).

Referring to claim 4, Kay discloses a booking certificate preparing means (see claim 2 above). Kay does not expressly disclose the booking certificate preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that the intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request of booking certificate corresponding to the verification information by referencing the booking certificate intermediation license, and prepares the booking certificate only when the intermediary is found to be licensed. Misra et al. disclose the booking certificate preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that the intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request of booking certificate corresponding to the verification information by referencing the booking certificate

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intermediation license, and prepares the booking certificate only when the intermediary is found to be licensed (see col.6, lines 31-35,55-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Kay to include disclose the booking certificate preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that the intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request of booking certificate corresponding to the verification information by referencing the booking certificate intermediation license, and prepares the booking certificate only when the intermediary is found to be licensed. One of ordinary skill in the art would have been motivated to do this because intermediary can be used to provide resources to consumers (see Misra et al. col. 2,lines 22-31).

7. Claims 24 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Kay as applied to claim 23 above, and further in view of Sehr.

Kay discloses a portable apparatus (see claim 23 above). Kay does not expressly disclose the portable memory unit comprises an IC card. Sehr discloses the portable memory unit comprises an IC card (see paragraphs [0031] and [0035]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Kay to include an IC card. One of ordinary skill in the art would have been motivated to do this because utilizing an IC card reduces possible security problems, which occurs during electronic transaction.

8. Claims 26 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. as applied to claim 25 and 17 respectively above, and further in view of Sehr.

Misra et al. discloses a portable apparatus (see col. 2, lines 43-46). Misra et al. do not expressly disclose the portable memory unit comprises an IC card. Sehr discloses the portable memory unit comprises an IC card (see paragraphs [0031] and [0035]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclosed by Kay to include an IC card. One of ordinary skill in the art would have been motivated to do this because utilizing an IC card reduces possible security problems, which occurs during electronic transaction.

#### *Allowable Subject Matter*

9. Claims 5-7 are allowed.

10. Claims 19 and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 5915022 to Robinson et al. discloses a method/apparatus for creating and using encrypted digital receipt for electronic transaction.

- US Patent No. 6205435 to Biffar discloses circulating digital vouchers with attached logs, which contain a history of the transaction experienced, by the voucher.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular and After Final Actions and 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks  
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October 21, 2004

